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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,328	10/24/2005	Jochen Ratjen	5082-2	8225
23117 7590 12/15/2008 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
NGUYEN, TRAN N				
ART UNIT		PAPER NUMBER		
3626				
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12/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/549,328

Applicant(s)

RATJEN ET AL.

Examiner

Tran Nguyen

Art Unit

3626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26, 28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

This communication is in response to the communication filed 10/01/2008.

Pending claim(s): 1-26, 28-29. Cancelled claim(s): 27. Amended claim(s): 14.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/29/2008 has been entered.

Response to Amendment

As per the rejection of claims 14-26, 28-29 under 35 USC 112, second paragraph imposed in the previous Office Action, this rejection is hereby withdrawn in view of Applicant's amendment to claim 14.

Claim Objections

Claim 17 is objected to because of the following informalities: "SMS" and "MMS". Acronyms may subject the claim to alternate interpretations.

Appropriate correction is requested.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim(s) 3, 16 is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 3, this claim recites "visualizing means" and "vibration means".

This claim is treated under 35 USC 112, 6th paragraph as required by MPEP 2181(I).

To avoid purely functional claiming in cases involving computer-implemented inventions, we have "consistently required that the structure disclosed in the specification be more than simply a general purpose computer or microprocessor." *Aristocrat Techs. Austl. Pty Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008). "Because general purpose computers can be programmed to perform very different tasks in very different ways, simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to 'the corresponding structure, material, or acts' that perform the function, as required by section 112 paragraph 6." *Id.* "Thus, in a means-plus-function claim 'in which the disclosed structure is a computer, or microprocessor, programmed to carry out an

algorithm, the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm.'" Id. (quoting WMS Gaming, Inc. v. Int'l Game Tech., 184 F.3d 1339, 1349 (Fed. Cir. 1999)). Consequently, a means-plus-function claim element for which the only disclosed structure is a general purpose computer is invalid if the specification fails to disclose an algorithm for performing the claimed function. See id. at 1337-38.

Applicant has not set forth the equivalent structure capable of providing these limitations. Therefore, this claim is indefinite.

As per claim 16, this claim is rejected for substantially the same rationale as applied to claim 3 above, and incorporated herein.

Additional clarification is requested.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1-7, 9-26, 28-29 is/are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson (WO0124690A2, cited by Applicant on the IDS submitted 09/16/2005).

As per claim 1, Applicant admits that Anderson teaches a system (Specification as filed on 03/05/2004; page 2 line 8) capable of feeding information (reads on "presenting and distributing") to a network computer system (Specification; page 2 line 17-18), wherein the fed information comprises compliance information (Specification; page 2 line 18) based on the delivery of a medicament (Specification; page 2 line 8), the system comprising:

(a) a network computer system (reads on "a terminal device") (Specification; page 2 line 10) capable of communicating via a wireless network such as a telephone network (Specification; page 2 line 10, 14-15);

(b) a dose inhaler comprising push-buttons and a display (reads on "a medicament device") (Specification; page 2 line 9, 20-21), comprising:

(i) the dose inhaler (reads on "a medicament container") capable of storing medicament for delivery to a patient (Specification; page 2 line 8-9);

(ii) the dose inhaler capable of delivering medicament to the patient (It is noted that the portion of the dose inhaler capable of being used to interface with the patient to inhale the medicament is considered to be "a dispensing mechanism" capable of "dispensing medicament from the medicament container", wherein medicament "s delivered from the dose inhaler's storage compartment to the patient via the inhaler interface) (Specification; page 2 line 8-9).

Anderson further teaches:

(iii) a detector capable of detecting dispensing from the medicament container (page 8 line 24-26);

(iv) the system is capable of predicting the optimum amount of medicament to dispense (reads on "a memory arranged for obtaining and storing patient-specific information related to specific medication of the patient") (page 7 line 28-29), and receiving a plurality of information from the device, including patient compliance information, (page 7 line 1-4), environmental data (page 7 line 6-8), user vital signs (page 8 line 32-35), etc.;

(v) a cell phone (reads on "a communication device") capable of communicating with the telephone network (reads on "wireless communication system"), wherein the data from element (iv) above is transferred to the central computer (reads on "transmission of data is activated depending on information from said detector", wherein the transmission of data depends on the data available for transmission) (page 4 line 28-35);

(vi) wherein the device is capable of bi-directional communication with the central computer (page 4 line 28-35, page 13 line 20), and is further capable of receiving medication data to vary the dose for delivery to the patient (page 13 line 25-27) and displaying any received data to the patient (page 7 line 24-26, also admitted by Applicant on page 2 line 20-22 of the Specification).

Applicant is suggested to not argue features admitted by Applicant as being taught by Anderson because these features have been admitted as prior art by Applicant.

Even assuming *arguendo* that Anderson does not teach any of these features (wherein Examiner strongly asserts that Anderson teaches all features admitted by Applicant on page 2 of the Specification), these features are nonetheless considered to be admitted prior art based on Applicant's characterization of Anderson.

As per claim 2, Anderson teaches that a physician is capable of receiving patient-collected diagnostic data transferred from dispenser (page 6 line 6-16).

As per claim 3, Anderson teaches an LED/LCD screen (reads on "visualizing means" and "light means") (column 7 line 24-26).

As per claims 4-5, Anderson teaches that the network computer system is capable of two-way data transfer with the inhaler via the cell phone (page 13 line 20).

As per claim 6, Anderson teaches compliance data (reads on "an incorrect amount... was dispensed" and "not dispensed at a designated time"), as discussed above and incorporated herein.

As per claim 7, Anderson teaches memory capable of storing patient data (Figure 7).

As per claim 9, Anderson teaches encryption (Figure 6 label 593, Figure 7 label 624).

As per claims 10-11, Anderson teaches Bluetooth (reads on "radio frequency" and "spread spectrum radio frequency signals") (page 4 line 33-35) and infra red (reads on "optical signals") (page 5 line 4-6).

As per claims 12-13, Anderson teaches that the information is capable of being provided to a plurality of authorized users (reads on "at least two terminal devices") (page 6 line 23-27). Anderson further teaches bi-directional communication via the network for purposes of dosage, maintenance, and other system functions, as discussed above and incorporated herein.

As per the set of claim(s): 14, 15, 16, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 1, 2, 3, respectively, and incorporated herein.

As per claim 17, Anderson teaches SMTP email communications (reads on "SMS" and "MMS" messages) (page 4 line 21).

As per the set of claim(s): 18, 19, 20, 21, 22, 23, 24, 25, 26, 28, 29, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 4, 5, 6, 7, 9, 10, 11, 12, 13, 1, 6, respectively, and incorporated herein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim(s) 8 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Official Notice.

As per claim 8, Anderson teaches a central controller (Figure 6) capable of interfacing over a cell phone network, as discussed above and incorporated herein.

Anderson does not teach "the terminal device is a cellular phone".

As discussed above, Anderson teaches that cell phones are known in the art.

Official Notice is taken that providing telephone functionality on a computer is old and well established in the art of network communication.

All component parts are known. The only difference is the combination of "old elements" into a single embodiment.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of the Official Notice within the embodiment of Anderson, since the operation of the cell phone operation is in no way dependent on computer, and a standard communication protocol may be used with a computer to achieve the predictable result of providing multi-function computers.

Response to Arguments

Applicant's arguments filed 08/29/2008 have been fully considered but they are not persuasive.

These arguments have been substantially addressed in the Office Action mailed 09/24/2008 with respect to the previously applied art.

Nevertheless, Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran (Ken) N. Nguyen whose telephone number is 571-

270-1310. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:00 pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./
Examiner, Art Unit 3626
12/04/2008

/Robert Morgan/
Primary Examiner, Art Unit 3626